

REMARKS

The Office Action mailed September 23, 2003, has been received and reviewed. Claims 1-19 are currently pending in the application and stand rejected. Applicant has amended claims 1-19 and respectfully requests reconsideration of the application as amended herein.

35 U.S.C. § 103 Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,424,523 to Ohno et al.

Claims 1-3, 5-9, and 17-19 stand rejected under 35 U.S.C. § 103(a) ("Section 103") as being unpatentable over United States Patent No. 5,424,523 to Ohno et al. ("Ohno"). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103 rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Section 103 rejection of claims 1-3, 5-9, and 17-19 is improper because Ohno, when combined with the knowledge of one of ordinary skill in the art, does not teach or suggest all the claim limitations.

Ohno discloses a record medium having two magnetic record layers. The record medium is a pre-printed ticket that is fed through a ticket machine to visualize the magnetic information on the magnetic record layers.

Ohno does not teach or suggest all the limitations of amended claim 1 because Ohno does not disclose "at least one magnetic layer in contact with the base layer, wherein the at least one magnetic layer comprises a layer of homogenous, magnetic material upon which magnetically encoded information is recorded." As acknowledged by the Examiner, Ohno does not disclose a magnetic layer that comprises a layer of homogenous, magnetic material. Office Action of September 23, 2003, p. 3. Ohno is completely silent about the types of magnetic materials used, the form in which the

magnetic record layers are present, or that a homogenous magnetic material is used to form the magnetic record layers. Since Ohno does not disclose that its magnetic record layers comprise a layer of homogenous, magnetic material, Ohno does not describe the magnetic layer of the present invention in as complete detail as is recited in claim 1.

However, the Examiner states that “[i]t would have been obvious . . . to provide any desired material for the magnetic layer as deemed necessary by the end user, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.”

Id. However, even assuming *arguendo* that this statement is true, all of the limitations of the claimed invention still would not be taught or suggested because Ohno does not disclose that its magnetic record layer is formed from a homogenous magnetic material.

Ohno also does not teach or suggest “at least one ink receptive layer in contact with the at least one magnetic layer, wherein the at least one ink receptive layer absorbs laser ink or inkjet ink thereon,” as recited in claim 1. Ohno discloses that information printed on its pre-printed ticket is applied to a print layer using a heat-transfer recording system but is silent about any other details of the print layer. As such, Ohno does not disclose that its print layer absorbs laser ink or inkjet ink. In addition, Ohno does not provide any teaching or suggestion that the information is printed on the record medium using a laser printer or an inkjet printer. Ohno also does not suggest that the record medium is capable of being used in a laser printer or inkjet printer. In other words, this record medium is not a blank piece of print medium for use in a laser or inkjet printer. Rather, this ticket is pre-printed with information. Magnetic information is recorded on the magnetic record layers.

Since Ohno and the knowledge of one of ordinary skill in the art do not teach or suggest all the limitations of claim 1, Applicant respectfully submits that the obviousness rejection of claim 1 is improper and should be withdrawn.

Claims 2, 3, and 5-9 are allowable, *inter alia*, as depending on an allowable base claim.

Claim 2 is further allowable because Ohno does not disclose a base layer that supports the magnetic printing medium as it is transported through a laser printer or an inkjet printer.

Claim 3 is further allowable because Ohno does not disclose a base layer having a printable surface.

Claim 5 is further allowable because Ohno does not disclose that a base layer and an ink receptive layer both receive laser ink or inkjet ink.

Claim 8 is further allowable because Ohno does not disclose magnetically encoded information that is textual and graphical information.

Claim 9 is further allowable because Ohno does not disclose a magnetic layer adhered to a base layer or an ink receptive layer adhered to a magnetic layer.

Ohno also does not teach or suggest all the limitations of amended claim 17 because it does not disclose "printing information on the ink receptive layer using an inkjet printer or a laser printer," as discussed above with reference to the obviousness rejection of claim 1. Since Ohno only discloses that information is printed using a heat-transfer recording system, Ohno necessarily does not disclose that the information is printed on its print layer using an inkjet printer or a laser printer.

Since Ohno and the knowledge of one of ordinary skill in the art do not teach or suggest all the limitations of claim 17, Applicant respectfully submits that the obviousness rejection of claim 17 is improper and should be withdrawn.

Claims 18 and 19 are allowable, *inter alia*, as depending on an allowable base claim.

Claim 19 is further allowable because Ohno does not disclose transporting the magnetically encoded, printed document through an inkjet or laser printer.

Obviousness Rejection Based on Ohno in View of U.S. Patent No. 5,916,673 to Fryberg et al.

Claim 4 stands rejected under Section 103 as being unpatentable over Ohno in view of United States Patent No. 5,916,673 to Fryberg et al. ("Fryberg"). Applicant respectfully traverses this rejection, as hereinafter set forth.

The Section 103 rejection of claim 4 is improper because Ohno and Fryberg do not teach or suggest all the limitations of claim 4 and do not provide a suggestion or motivation to combine to produce the claimed invention.

Fryberg discloses a recording sheet for inkjet printing. The recording sheet includes a support having a coating that is receptive for aqueous inks. The coating

includes film forming, hydrophilic polymers and a trivalent salt of a metal of Group IIIB of the Periodic Table of the Elements.

Claim 4 depends from claim 1 and, therefore, includes all the limitations of claim 1. As discussed above in the obviousness rejection of claim 1, Ohno does not teach or suggest all the limitations of claim 1. Specifically, Ohno does not teach or suggest "at least one magnetic layer in contact with the base layer, wherein the at least one magnetic layer comprises a layer of homogenous, magnetic material upon which magnetically encoded information is recorded" or "at least one ink receptive layer in contact with the at least one magnetic layer, wherein the at least one ink receptive layer absorbs laser ink or inkjet ink thereon," as recited in claim 1. The Examiner states that "Fryberg is used solely for disclosing coating an ink receptive layer and has not been relied upon for disclosing any of the other claimed limitations." *Id.* at p. 7. Therefore, Fryberg does not teach or suggest the limitations of claim 1 that are lacking in the teachings of Ohno. As such, even if the cited references were combined, the cited references would not teach or suggest all the limitations of claim 4.

The cited references also do not provide a motivation to combine to produce the claimed invention. To provide a motivation or suggestion to combine, the prior art or the knowledge of a person of ordinary skill in the art must "suggest the desirability of the combination" or provide "an objective reason to combine the teachings of the references." M.P.E.P. § 2143.01. The Examiner states that "it would have been obvious . . . to modify Ohno's invention to include a coating on the ink receptive layer that increases receptivity, as taught by Fryberg et al., to retain the printing received on the ink surface that would diminish over time without the use of the coating." Office Action of September 23, 2003, p. 5. However, neither Ohno nor Fryberg suggest the desirability of, or provide an objective reason for, having at least one ink receptive layer that comprises a surface coated onto the ink receptive layer to increase the ink receptivity of the surface.

Finally, even if Ohno and Fryberg were combined, the claimed invention would not be produced because the resulting magnetic printing medium would not have a magnetic layer that comprises a layer of homogenous, magnetic material or an ink receptive layer that absorbs laser or inkjet ink.

Since the cited references do not teach or suggest all the limitations of claim 4 and do not provide a motivation to combine, Applicant respectfully submits that the obviousness rejection of claim 4 is improper and should be withdrawn.

Obviousness Rejection Based on United States Patent No. 4,114,032 to Brosow et al. in View of Ohno

Claims 10-15 stand rejected under Section 103 as being unpatentable over United States Patent No. 4,114,032 to Brosow *et al.* ("Brosow") in view of Ohno. Applicant respectfully traverses this rejection, as hereinafter set forth.

The obviousness rejection of claim 10 is improper because Brosow and Ohno do not teach or suggest all the claim limitations and do not provide a suggestion or motivation to combine to produce the claimed invention.

Brosow discloses a magnetic material having fibers coated with a magnetic or magnetizable material that are imbedded in a binder agent.

Ohno does not teach or suggest the limitations of "at least one magnetic layer upon which magnetically encoded information is recorded, the at least one magnetic layer comprising a layer of homogenous, magnetic material, wherein the at least one magnetic layer is adhered to the base layer," as recited in claim 10. Ohno also does not teach or support the limitations of "at least one ink receptive layer upon which printed information is recorded, wherein the at least one ink receptive layer absorbs laser ink or inkjet ink, wherein the at least one ink receptive layer is adhered to the at least one magnetic layer, and wherein the authenticity of the document is verified by determining whether the magnetic layer contains the magnetically encoded information," as recited in claim 10. Specifically, Ohno does not disclose that its magnetic record layer includes a layer of homogenous, magnetic material or that its print layer absorbs laser ink or inkjet ink.

The Examiner asserts that Brosow discloses the claimed invention "except for the particular arrangement of the layers of the magnetic media." *Id.* However, Brosow does not teach or suggest the limitations that are lacking in Ohno and, therefore, Brosow does not cure these deficiencies in Ohno. Brosow does not teach or suggest a base layer, at least one magnetic layer, or an ink receptive layer. For instance, the base material in Brosow is not a discrete layer upon which the other layers are adhered, the

magnetic fibers or filaments are embedded in a base material and are not formed in a discrete magnetic layer, and Brosow does not disclose an ink receptive layer.

The cited references also do not provide a suggestion or motivation to combine to produce the claimed invention. The Examiner states that "it would have been obvious . . . to modify Brosow's invention to include a printing media having the above disclosed arrangement, as taught by Ohno et al., to provide a secure document that contains encoded information that can not be easily reproduced." *Id.* The Examiner further states that "[i]t would have been obvious . . . to provide any desired material for the magnetic layer as deemed necessary by the end user, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice." *Id.*

However, these reasons provided by the Examiner are not objective reasons that support combination. In addition, nothing in Brosow and Ohno suggests the desirability of, or provides an objective reason for, combining the cited references. Furthermore, even if Brosow and Ohno were combined, the claimed invention would not be produced because the resulting magnetic layer would not comprise a layer of homogenous, magnetic material. Additionally, the base layer, magnetic layer, and ink receptive layer would not be adhered to one another.

Since the cited references do not teach or suggest all the limitations of claim 10, Applicant respectfully submits that the obviousness rejection of claim 10 is improper and should be withdrawn.

Claims 11-15 are allowable, *inter alia*, as depending on an allowable base claim.

Claim 12 is further allowable because Brosow and Ohno do not teach or suggest that the magnetically encoded information is identical in content to the printed information.

Claim 13 is further allowable because the cited references do not teach or suggest that the magnetic layer and the ink receptive layer record encoded information and printed information simultaneously.

Obviousness Rejection Based on Brosow in View of Ohno and Further in View of Fryberg

Claim 16 stands rejected under Section 103 as being unpatentable over Brosow in view of Ohno and further in view of Fryberg. Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 16 depends on claim 10 and, therefore, includes all the limitations of claim 10. As discussed in the obviousness rejection of claim 10, Brosow and Ohno do not teach or suggest the limitations of “at least one magnetic layer upon which magnetically encoded information is recorded, the at least one magnetic layer comprising a layer of homogenous, magnetic material, wherein the at least one magnetic layer is adhered to the base layer” or “at least one ink receptive layer upon which printed information is recorded, wherein the at least one ink receptive layer absorbs laser ink or inkjet ink, wherein the at least one ink receptive layer is adhered to the at least one magnetic layer, and wherein the authenticity of the document is verified by determining whether the magnetic layer contains the magnetically encoded information.” Furthermore, the Examiner states that “Fryberg is used solely for disclosing coating an ink receptive layer and has not been relied upon for disclosing any of the other claimed limitations.” *Id.* at p. 7. Therefore, Fryberg does not teach or suggest the limitations of claim 10 that are lacking in the teachings of Ohno and Brosow. As such, even if the cited references were combined, the cited references would not teach or suggest all the limitations of claim 16.

The cited references also do not provide a motivation to combine. The Examiner states that “it would have been obvious . . . to modify Brosow’s invention to include a coating on the base layer that increases ink receptivity, as taught by Fryberg et al., to retain the printing received on the surface that would diminish over time without the use of the coating. *Id.* at p. 6. However, the cited references do not suggest the desirability of, or provide an objective reason for, having at least one ink receptive layer that comprises a surface coated onto the ink receptive layer to increase the ink receptivity of the surface.

Finally, even if Ohno, Brosow, and Fryberg were combined, the claimed invention would not be produced because the resulting magnetic printing medium would

not have a magnetic layer that comprises a layer of homogenous, magnetic material or an ink receptive layer that absorbs laser or inkjet ink.

Since the cited references do not teach or suggest all the limitations of claim 16 and do not provide a motivation to combine, Applicant respectfully submits that the obviousness rejection of claim 16 is improper and should be withdrawn.

ENTRY OF AMENDMENTS

The amendment to claims 1-19 should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 1-19 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully Submitted,



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